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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,796	11/14/2001	Heinz Focke	20605.007US	3093

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LAURENCE P. COLTON
1201 WEST PEACHTREE STREET, NW
14TH FLOOR
ATLANTA, GA 30309-3488

EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,796

Applicant(s)

FOCKE ET AL.

Examiner

Thanh K. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 16-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 7-11 and 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 20, 2006 has been entered.

2. In the Remarks filed February 20, 2006, the Applicant's reinstatement of the withdrawn claims 2, 3, 7-11 and 16-19 is improper, because the independent claims 1 and 6 are not allowable at this time.

Therefore, claims 2, 3, 7-11 and 16-19 are remained withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species and Subspecies, there being no allowable generic or linking claim.

Accordingly, claim 23, the newly added claim that depends on claim 2 (the withdrawn claim) is also withdrawn from further consideration pursuant to 37 CFR 1.142(b).

3. Applicant's cancellation of claims 4, 5, 12-15 and 20 is acknowledged.

4. Claims 1, 6, 21 and 22 are being examined in this office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamberini (3,551,245) in view of Terranova (5,470,300).

Gamberini discloses (figures 1-5) a method and apparatus comprising:

providing a material strip (S) with precisely positioned markings (E) and producing tear-open strips (S) with the precisely positioned markings thereon;

attaching the tear-open strips (S) with the precisely positioned markings thereon to a continuous film web (N1) from which individual blanks (N2) for the outer wrapper comprising the tear-open strips are produced (figures 2, 4 & 5);

severing the individual blanks (N2) for the outer wrapper from the continuous film web (N1).

Gamberini discloses the claimed invention, but does not expressly disclose the sensing of the markings on the film web.

Terranova discloses an apparatus and a process comprising: printed-marks (26) are printed on the web (12); a sensor or printed mark reader (28) and a controller (30 – evaluation unit). Sensor or printed mark reader (28) detects each of the printed-mark (26) and sends a detection signal to the controller (30). The evaluation unit uses the detection signal to control the web registration system, servomotor, drive motor and

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cutting operation (figures 1 & 2). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Gamberini apparatus by incorporating the sensor or printed-marks reader on the web material, and the evaluation unit as taught by Terranova to provide a faster speed of production and more accurate web registration system.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gamberini (3,551,245) in view of Terranova (5,470,300) and Focke et al. (5,931,292).

As discussed above in paragraph 6 of this office action, the modified Gamberini by Terranova discloses the claimed invention, but does not expressly disclose that the material strip for producing the tear-open strip is from a separate strip supply reel.

Focke et al. discloses a method and apparatus in which the material strip (22) for producing the tear-open strip is from a separate strip supply reel (34) (figure 4).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Gamberini apparatus by incorporating the separate strip supply reel as taught by Focke to provide a more independent and flexible tear-open strip supply system, since it is well known and within the general skill of a worker in the art to select a known design configuration on the basis of its suitability for the intended use as matter of obvious design choice.

Response to Arguments

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

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9. In response to Applicant's argument that Terranova '300 is nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174.

In this case, Terranova '300 was relied upon to show that using the printed mark reader (sensor 28) to detect the printed-marks and in turn to control the cutting of the blank from the web (that contains printed-marks 26) is old and well known in the art. Furthermore, Gamberini discloses the tear-open strips with the printed-marks, therefore, it is obvious and within the skill of one in the art to incorporate the printed-mark reader as taught by Terranova '300 to further improve the accuracy of the control of the cutting of the blank from the web material base on the detection of the printed-mark on the web.

10. In response to Applicant's argument that "in the present invention, a pre-inked or pre-marked tear-open strip that cannot be modified is used", Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements, a pre-inked or pre-marked tear-open strip are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must

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be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064.

11. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures take as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, Gamberini discloses an apparatus and a method of providing a material strip with precisely position marking to produce a tear-open strip, and the tear-open strip is applied to the wrapping material, and the wrapping material is then cut into individual blanks for use as the outer wrapper.

Terranova '300 teaches that the precision of the cutting of a blank (off the web) can be improved by incorporating a marking reader (a sensor) to detect the marking on the web, therefore it would have been obvious to one skill in the art to incorporate the printed-mark reader as taught by Terranova '300 to further improve the accuracy of the control of the cutting of the blank from the web (as in claims 6, 21 and 22).

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12. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

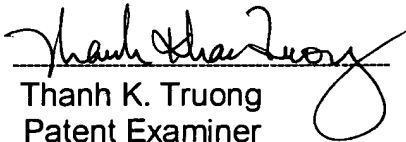
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thanh K. Truong
Patent Examiner
March 4, 2006.